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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,563	06/27/2000	Elvin R. Lukenbach	JBP-506	5312

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EXAMINER

BOYER, CHARLES I

ART UNIT PAPER NUMBER

1751

9

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/604,563**

Applicant(s)  
**Lukenbach et al**

Examiner  
**Charles Boyer**

Art Unit  
**1751**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 9, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-50, and 52-61 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-50, and 52-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

This action is responsive to applicants' amendment and response received September 9, 2002. Claims 1-7, 9-50, and 52-61 are currently pending.

#### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending Application

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No. 09/745270. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims contain essentially the same components.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 1, 3, 5, 9, 10, 17, 18, 25, 26, 30, 31, 33-35, 37, 38, 54-56, 60, and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Habib et al, US 5,989,572.

Habif et al teach compositions containing borage seed oil as an anti-irritant (see abstract). An example of such a composition is an oil in water emulsion comprising propylene glycol, hydroxyethyl cellulose, isopropyl palmitate, dimethicone, retinyl palmitate which is both an ester and a retinol derivative, sorbitan stearate, and water (col. 9, example 5). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Applicants have traversed all 102 rejections under one general argument and so the examiner's response which follows is meant to encompass all 102 rejections cited against the present claims. Applicants have traversed the rejections on the grounds that the references do not teach two water dispersible components and two liquid esters which form either a uniform hazy or uniform clear mixture when combined with water. The examiner notes that each example contains two esters so this claim limitation is satisfied. Are these esters not water dispersible? The references contain additional components including propylene glycol, glycerin, and ammonium hydroxide to name a few. Clearly this claim limitation is satisfied. As to the compositions being clear or hazy, the examiner notes that hazy is a very broad term which can be interpreted as meaning anything that is not clear. Therefore, any composition could fall into the category of clear or hazy. Accordingly, this claim limitation is satisfied and so the rejections are maintained.

Claims 1, 3, 9, 10, 17, 18, 25, 26, 30, 31, 33-35, 37, 38, 47, and 54-56, 60, and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Crotty et al, US 5,766,575

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Crotty et al teach a method and composition for skin lightening (see abstract). An example of such a composition is a water in oil skin lotion comprising butylene glycol, glycerin, cetyl dimethicone, octyl octanoate, isononyl isononanoate, and water (col. 8, example 3). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Claims 1, 3, 5, 9, 10, 17, 18, 21, 22, 25, 30, 31, 34-37, 45, 46, 54-56, 60, and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Znaiden et al, US 5,814,662.

Znaiden et al teach skin treatment compositions (see abstract). An example of such a composition comprises propylene glycol, xanthan gum, peg-20 sorbitan isostearate, dimethicone copolyol phosphate, vitamin E linoleate, and water (col. 6, example 2). Another example contains cyclomethicone, ethyl alcohol, and isopropyl ppg-2 isodeceth-7-carboxylate (col. 7, example 5) and yet another example contains isostearyl palmitate, alkyl octanoate, glycerol hydroxystearate, xanthan gum, dimethicone, vitamin E acetate, vitamin A palmitate, and water (col. 7, example 6). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Claims 1, 3, 5, 9-11, 23, 25-31, 33-35, 37, 38, and 54-56, 60, and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Jeffcoat et al, US 5,871,756.

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Jeffcoat et al teach skin and hair care compositions (see abstract). An example of such a composition is an aqueous based lotion comprising propylene glycol, Carbopol 941, octyl palmitate, alkyl benzoate, glyceryl stearate, dimethicone, copolyol, and water (col. 48, example 30). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

#### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, 9-50, and 52-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Znaiden et al, US 5,814,662.

Znaiden et al are relied upon as set forth above. Znaiden et al do not teach the specific mixtures of esters and dispersants presently claimed, nor do they teach each ultimate utility presently claimed. However, each of the presently claimed esters and dispersants are well known in the art for use in personal cleansing and cosmetic compositions. It would have been obvious to one of ordinary skill in the art to use well known esters and dispersants in the skin treatment compositions of Znaiden et al as esters and dispersants are taught as preferred components in their invention.

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*Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Boyer whose telephone number is (703) 308-2524. The examiner can normally be reached on Monday-Friday from 9:30 AM - 6:00 PM.

If reasonable attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Group is (703) 872-9310 for non-after-final amendments and (703) 872-9311 for after-final amendments.



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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Charles Boyer

A handwritten signature in cursive script that reads "Charles Boyer". The signature is written in black ink and is positioned to the right of the printed name "Charles Boyer".

October 18, 2002